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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,204	08/14/2001	Richard J. Saindon	SPECHE-06445	9588

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EXAMINER	
STORM, DONALD L	

ART UNIT	PAPER NUMBER
2654	

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,204	SAINDON ET AL.	
	Examiner	Art Unit	
	Donald L. Storm	2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *21 and 24* is/are allowed.

6)☒ Claim(s) *22 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 August 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

2. The drawings are objected to under 37 CFR § 1.83(a) because they fail to clearly show significant features of the subject matter specified in the claims. See MPEP § 608.02(d). At a minimum, representation of the following features should be added to the drawings to show the claimed invention as a whole:

a. serial port (claim 21);

b. transfer without a serial device attached to the serial port (claim 21);

c. a plurality of different captioning protocols (claim 21); and

d. converting text information from the plurality of different captioning protocols into ASCII (claim 21).

3. Corrected drawings (or drawings with proposed corrections highlighted, preferably in red ink) are required in response to this Office action. Corrections may no longer be held in abeyance. ANY REQUEST TO HOLD CORRECTIONS TO THE DRAWINGS IN ABEYANCE WILL NOT BE CONSIDERED A *BONA FIDE* ATTEMPT TO PROVIDE A COMPLETE REPLY. See 37 C.F.R. § 1.121(d) and § 1.85(a), published September 8 and September 20, 2000.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The claim is not adequately enabled by the disclosure because of the breadth of scope of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW claim element.

While being reasonably enabling for any CASEVIEW, SMARTENCODER, TAC, AND SIMULVIEW products that an artisan may be able to find today, the disclosure does not reasonably provide enablement for all other versions of all CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products. The disclosure does not provide an artisan with a way to identify the version of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products with which the Applicant has defined the claimed invention.

All versions of all CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products are not disclosed. The disclosure does not provide a starting point for one of ordinary skill in the art to make and use the invention commensurate with future versions of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products. Future versions of CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products are not within the ordinary skill of an artisan.

An amendment to the specification that specifically identifies the versions and dates of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products on which the Applicant is

relying should be sufficient to provide enablement. With such a starting point, it should be within the skill of an artisan to make and use the invention for any version of CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products.

In summary, designation in the specification of a dated reference for CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products is essential matter; incorporation of an entire standard into the disclosure is not necessary for enablement.

If the Applicant amends the specification to identify CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products with a date before the filing of this application, the Examiner will not regard such an amendment as new matter. In order to be afforded priority under 35 USC § 120, the Applicant should designate the same version of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products as set forth in the priority document and identify where in the priority documents the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW products are set forth.

It would be in the best interests of the patent community, however, for the Applicant to make of record and provide copies of the CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW guides that explain the claimed subject matter.

6. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Nothing in the disclosure as originally filed supports the subject matter of claim 23 by providing a description of the subject matter of prompting a user to identify the captioning protocol used.

The original disclosure does not clearly allow persons of ordinary skill in the art to recognize that the Applicant invented at that time what is now claimed. The disclosure (at page 23, lines 13-14) discusses getting the protocol identity by monitoring information from the captionist. The disclosure, as filed, [at page 23] thus might describe a user identifying the protocol, but prompting for that identification is not discussed. The Examiner does not find a discussion of these features and their relationships anywhere in the disclosure as filed.

Although the requirement can be satisfied either by "express" or "inherent" disclosure, even inherent disclosure must make the Applicant's possession of claimed invention obvious. The written description requirement thus cannot be satisfied by remaining entirely silent on a claimed embodiment.

7. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 22, the trademark/trade names "CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW" are indefinite. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or

product. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

In the present case, the trademark/trade name is used to identify/describe the sources/suppliers of the captioning software protocols as CASEVIEW, SMARTENCODER, TAC, and SIMULVIEW. Accordingly, the claim scope is uncertain since the recited protocols do not have a stable definition because the sources may change the characteristics of their products from time to time and yet may continue to sell it under the same trademark or trade name.

Response to Arguments

9. The prior Office action, mailed September 18, 2003 (paper 6), requires corrected drawings, objects to the drawings and abstract, and rejects claims under *35 USC § 102* and *§ 103*. The Applicant's arguments and changes in AMENDMENT AND RESPONSE TO OFFICE ACTION MAILED SEPTEMBER 18, 2003 filed March 22, 2004 (paper 8) have been fully considered with the following results.

10. With respect to objection to the drawings, the Applicant's arguments appear to be as follows:

a. The Applicant's argument appears to be that the illustration of features of the invention is not necessary to understand the invention. This argument is not persuasive because it is not directed to the basis of the objection. Basis can be found in 37 CFR 1.83(a), which reads in relevant part: "(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and

claims . . . should be illustrated in the drawing. . . . " Consequently, every claimed feature should be shown. It is in the best interests of the patent community that the drawings should show at least every feature of sufficient importance to be included in the independent claim.

b. The Applicant's argument appears to be that no additional features are needed in the drawings because those listed in the prior Office action appeared in claims that are now canceled. This argument is not persuasive because features of the current claims should be shown in the drawings, but are not illustrated.

The Applicant's arguments have been fully considered but they are not persuasive. Accordingly, the objection is maintained. Please see new grounds of objection based on current claims.

11. With respect to objection to the abstract, the changes entered by amendment are sufficiently descriptive. Accordingly, the objection is removed.

12. With respect to rejections of claims under *35 USC § 102* and *103*, the rejections no longer apply because the claims have been canceled. The newly presented independent claim includes different speech-to-text captioning software protocols that are converted into ASCII for Internet transmission without a serial IP device. The references of record do not explicitly describe that limitation. The whole structure expressed by the combination of all limitations compared to the prior art of record is not made obvious for the whole invention of the independent claim, particularly with captioning software. The Applicant's assertions with respect to the references have been considered, but they are moot in view of the whole structure of the new independent claim.

Conclusion

13. The following references here made of record are considered pertinent to applicant's disclosure:

Hulen et al. [US Patent 5,497,373] describes conversion by software of protocols between those of a host and various telecommunications formats employed by diverse equipment.

Master et al [US Patent 6,237,029] describes software that can automatically determines the format of streamed data or can prompt the user to select it.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any response to this action should be mailed to:

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 872-9306, (for informal or draft communications, and please label "PROPOSED" or "DRAFT")

Patent Correspondence delivered by hand or delivery services, other than the USPS, should be addressed as follows and brought to U.S. Patent and Trademark Office, 220 20th Street S., Customer Window, **Mail Stop AF**, Crystal Plaza Two, Lobby, Room 1B03, Arlington, VA, 22202

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Storm, of Art Unit 2654, whose telephone number is (703) 305-3941. The examiner can normally be reached on weekdays between 8:00 AM and 4:30 PM Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or

703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by

e-mail at: ebc@uspto.gov.

Donald L. Storm

Donald L. Storm
June 8, 2004

RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER